

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN P. WEHRLE and ALBERT G. HOLDER

Appeal No. 2002-2071
Application 09/428,451

ON BRIEF

Before KIMLIN, OWENS and WALTZ, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

ON REQUEST FOR REHEARING

The appellants request reconsideration of our decision mailed November 21, 2002, wherein we affirmed the rejection of claims 2, 3, 5, 6 and 8 under 35 U.S.C. § 103 over the appellants' admitted prior art in view of Morishige and further in view of Scollard and/or Gray.

The appellants argue (request, pages 1-2) that we concluded that "the combined teachings of the references would have fairly suggested the appellants' claimed invention to one of ordinary skill in the art" (decision, page 5) without referring to or commenting on the appellants' argument that "[i]n view of the foregoing referred to ... factual evidence, the burden of providing a proper basis for a legal judgment of obviousness under 35 U.S.C. § 103(a) has not been met" (brief, page 5). The "foregoing referred to ... factual evidence" referred to by the appellants is the appellants' statement regarding what each piece of applied prior art discloses separately (brief, page 4). Our response was as follows (decision, page 5):

The appellants argue that none of the admitted prior art, Morishige, Scollard or Gray discloses all elements of the claimed invention (brief, page 4). This argument is not well taken because the appellants are attacking the references individually when the rejection is based on a combination of references. See *In re Keller*, 642 F.2d 413, 426, 208 USPQ 871, 882 (CCPA 1981); *In re Young*, 403 F.2d 754, 757-58, 159 USPQ 725, 728 (CCPA 1968). As discussed above, the combined teachings of the references would have fairly suggested the appellants' claimed invention to one of ordinary skill in the art.

Thus, we referred to and commented on the appellants' argument. The appellants do not allege that our response to this argument was in error.

The appellants argue that Morishige lacks any teaching to interrelate Morishige's corrosion resistant paint with a sealant in a mechanical attachment (request, page 2). For the reason given in the paragraph bridging pages 4 and 5 of our decision, this interrelation would have been fairly suggested to one of ordinary skill in the art by the applied prior art as a whole.

The appellants argue that we used improper hindsight in characterizing Morishige's adhesive as an adhesive/sealant (request, page 2). Support for our characterization of Morishige's adhesive as an adhesive/sealant is found at column 3, lines 34-39 of Morishige, wherein it is disclosed that the adhesive provides adhesiveness and moisture resistance.

The appellants urge the board to more carefully consider the disclosure in the appellants' specification that currently known methods would thermally destroy or remove corrosion resistant paint, and that the appellants' sealant rapidly solidifies and thereby minimizes attachment duration and avoids adversely affecting the corrosion resistant property of the paint (request, page 2). This argument is not well taken because it does not allege any error in our decision.

Appeal No. 2002-2071
Application 09/428,451

The appellants request that we sanction their amendment after appeal (request, page 3). The appellants have no right to entry of an amendment after appeal unless it is in conformity with an explicit statement in the board decision that a claim may be allowed in amended form. See 37 CFR § 1.196(c)(1997). Our decision contains no such explicit statement.

We have considered the appellants' request for reconsideration of our decision but, for the above reasons, we decline to make any change to the decision.

DENIED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
TERRY J. OWENS)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
THOMAS A. WALTZ)	
Administrative Patent Judge)	

TJO/ki

Appeal No. 2002-2071
Application 09/428,451

John Forrest
Office of Counsel Code 004
Naval Surface Warfare Center
9500 MacArthur Blvd Carderock Div.
West Bethesda, MD 20817